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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,811	NATHAN ET AL.	
	Examiner	Art Unit	
	JOSHUA MURDOUGH	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 July 2010.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 43,44,47-54,57-62 and 65-81 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 43,44,47-54,57-62 and 65-81 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants' IDS received 26 October 2010.
2. This action has been assigned paper number 20101119 for reference purposes only.
3. Claims 43, 44, 47-54, 57-62, and 65-81 are pending.
4. Claims 43, 44, 47-54, 57-62, and 65-81 have been examined.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a. "a first storage location" in at least claim 43;
- b. "a second storage location" in at least claim 43;
- c. "a common type" in at least claim 43;
- d. "encryption level" in at least claim 50; and
- e. "programmed logic circuitry" in at least claim 75.

Claim Rejections - 35 USC § 112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 43, 44, 47-54, 57-62, and 65-81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Claim 1 recites “wherein each said instance of media in the first and second storage locations is of a common type.” The original disclosure does not discuss “types” of instances of media. Because the original disclosure does not discuss types of instances of media, it also does not discuss instances of media being of a common type. Because the original disclosure does not discuss types or a common type of instances of media, the limitation “wherein each said instance of media in the first and second storage locations is of a common type” is not necessarily present in the original disclosure. Because the limitation “wherein each said instance of media in the first and second storage locations is of a common type” is not necessarily present in the original disclosure, it is new matter. Because claim 43 contains new matter, claim 43 is rejected under 35 U.S.C. § 112 1st paragraph.

9. Claims 53, 61, and 71 contain similar limitations to the limitation in claim 43 discussed in the previous paragraph. Because claims 53, 61, and 71 contain similar limitations to the limitation in claim 43 discussed in the previous paragraph, they are similarly rejected under 35 U.S.C. § 112 1st paragraph for containing new matter.

10. Claims 43 and 53 recite “a first storage location” and “a second storage location” as part of “a jukebox device.” As noted above, the specification does not make reference to either “a

first storage location" or "a second storage location." Figure 7 does show IDE controllers (78 and 80) with multiple hard disk drives (82, 84, 86, and 88). However, the IDE controllers and disk drives are part of the local server (22). In Figure 2, the jukebox devices (16) are shown as separate from the local servers (22). Therefore, these disk drives are not shown as part of the jukebox device. The Examiner, upon rereading the specification, could not find any indication that there were multiple storage locations in the jukebox as originally disclosed. In order to provide more relevant prior art, the Examiner has interpreted these claims as being directed toward a jukebox system instead of a jukebox device when applying the prior art.

11. Applicants have contended that the "second storage location" corresponds to the "local server" (Remarks, Page 14, Paragraph 1). However, Paragraph [0009] of Applicant's specification states "[i]n other words, the user can first search the local storage on the jukebox for desired songs and then, if desired, search further on the local server for desired songs." Applicants contend that paragraph [0010] contains support for the local server being part of the jukebox (Remarks, Page 14, Paragraph 1). However, paragraph [0010] discusses updating the local server with data, without mentioning any storage on the jukebox device. Therefore, Applicant's assertion that the local server is shown to be part of the jukebox device is unsupported by paragraph [0010]. Because Applicant's assertion is unsupported, the Examiner again finds that according to Applicant's specification, the local server is distinct from the local storage. Because the local server is distinct from the local storage, Applicants' specification does not show adequate support for the local server being a second storage location.

12. Claims 61 also recites "a first storage location" and "a second storage location" and is therefore rejected under the same rationale as claims 43 and 51.

13. Claims 81 also recites a “jukebox device...comprising first and second storage locations” and is therefore rejected under the same rationale as claims 43, 51, and 61.

14. Claim 71 recites “at least one storage location.” Because “at least one,” can include a second, claim 71 is rejected under the same rationale as claims 43, 53, 61, and 81.

15. Claim 75 recites “media is searched by programmed logic circuitry.” The original disclosure does not discuss programming logic circuitry. Therefore, the original disclosure also does not discuss programming logic circuitry to perform a search. Because the original disclosure does not disclose programmed logic circuitry performing a search, the limitation of “media is searched by programmed logic circuitry” is not necessarily present in the original disclosure. Because “media is searched by programmed logic circuitry” is not necessarily present in the original disclosure, it is new matter. Because the limitation “media is searched by programmed logic circuitry” is new matter, claim 75 is rejected under 35 U.S.C. § 112 1st paragraph.

16. Claims 76 and 77 contain similar limitations to the limitation in claim 75 discussed in the previous paragraph. Because claims 76 and 77 contain similar limitations to the limitation in claim 75 discussed in the previous paragraph, they are similarly rejected under 35 U.S.C. § 112 1st paragraph for containing new matter.

Claim Rejections - 35 USC § 112 2nd Paragraph

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 43, 44, 47-54, 57-62, and 65-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. Claim 43 recites “each instance of media...is of a common type.” The word “type” is subject to several mutually exclusive interpretations. “Type” could correspond to the file format (mp3, wav, wmp, etc.), the content (audio, video, text, etc.), or genre (rock, country, blues, etc.). Because the word “type” is subject to multiple interpretations in the context of the claim, claim 43 is rendered indefinite under 35 U.S.C. § 112 2nd paragraph for failing to set for the metes and bounds of the invention.

20. Claims 53, 61, and 71 contain similar limitations to the limitation in claim 43 discussed in the previous paragraph. Because claims 53, 61, and 71 contain similar limitations to the limitation in claim 43 discussed in the previous paragraph, they are similarly rejected under 35 U.S.C. § 112 2nd paragraph for being indefinite.

21. In claims 50, 51, 68, and 69, the phrase “encryption level” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner’s position that the phrase “encryption

level" (as used in the context of these particular claims) is not known to those of ordinary skill in this art.

22. The Examiner acknowledges that there are mutually exclusive interpretations in the art for levels or layers of encryption. See Stefik (US 2005/0086172) Table 2, Schneier (Applied Cryptography) Page 216 "Encrypting Communications Channels," Schneier Page 222 "Driver-Level vs. File-Level Encryption," and Schneier Page 584 "Pretty Good Privacy." Each of these citations is to descriptions of layers or levels of encryption and security. However, Applicants have not included any indication which, if any, of these mutually exclusive implementations they are claiming. Because the claims are subject to mutually exclusive interpretations, they are indefinite under 35 U.S.C. § 112 2nd paragraph.

23. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 43-44, 47-49, 53-54, 57-62, and 65-67, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles (US 5,481,509) in view of Verduin (US 4,667,802).

26. As to claim 43, Knowles shows:

- f. A jukebox device **5**, comprising:
- g. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media (Figure 4A, step 120) available for playback via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);
- h. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5) following collection of an appropriate fee or number of credits (Steps 152 and 154), and
- i. wherein each said instance of media in the first and second storage locations is of a common type (common types include music **206**, video **202**, and karaoke **204**).

27. Knowles does not expressly show:

- j. a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.
- k. wherein the first storage location is different from the second storage location.

28. However, Verduin shows a record player **42** which plays audio selections for a first price (Abstract and claim 1) as well as a VCR **54** which plays audio-video selections for a second price (Abstract and claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks **52** for different priced media because then the computer could identify the hard disk and charge accordingly instead of having to add metadata to the files or create a lookup table.

29. As to claim 44, Knowles further shows:

1. the first and second storage locations respectively comprise first and second disk drive devices(Figure 2).

30. As to claim 47, Knowles further shows:

m. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

31. As to claim 48, Knowles further shows:

n. the first and second storage locations are updatable independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown

as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

32. As to claim 49, Knowles further shows:

o. a selected instance of media from said second plurality of instances of media becomes at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

33. As to claim 53, Knowles shows:

p. A digital audiovisual distribution network, comprising:
q. a plurality of jukebox devices respectively located at a plurality of locations; and
r. a central server **100** including a repository **112** of instances of media distributable to the jukebox devices via the network (Column 5, lines 51-61);
s. wherein each said jukebox device (Figure 2) comprises:
t. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);
u. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the

selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5) following collection of an appropriate fee or number of credits (Steps 152 and 154), and

v. wherein each said instance of media in the first and second storage locations is of a common type (common types include music **206**, video **202**, and karaoke **204**).

34. Knowles does not expressly show:

w. a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.

x. wherein the first storage location is different from the second storage location.

35. However, Verduin shows a record player **42** which plays audio selections for a first price (Abstract and claim 1) as well as a VCR **54** which plays audio-video selections for a second price (Abstract and claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks **52** for different priced media because then the computer could identify the hard disk and charge accordingly instead of having to add metadata to the files or create a lookup table.

36. As to claim 54, Knowles further shows:

y. the first and second storage locations respectively comprise first and second disk drive devices (top/middle **52** in Figure 2).

37. As to claim 57, Knowles further shows:

z. the second plurality of instances of media substantially mirrors the repository of instances of media operably connected to the central server (Column 5, lines 21-33).

38. As to claim 58, Knowles further shows:

aa. the first and second storage locations are updatable via the network independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

39. As to claim 59, Knowles further shows:

bb. an instance of media from said second plurality of instances of media selected for playback is at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

40. As to claim 60, Knowles further shows:

cc. an instance of media stored in the repository of the central server, subsequent to user request, is downloadable to a storage location of one said jukebox device (Column 5, lines 21-33) for a third fee or number of credits (as evidenced by Figure 4A, step 136), the third fee or number of credits being higher than the second fee or number of credits

(multiple prices are disclosed, if there are 3 prices, one is going to be the highest, one will be the middle, and one will be the lowest).

41. As to claim 61, Knowles shows:

dd. A method of operating a jukebox device, comprising:
ee. providing a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);
ff. receiving, via a user interface provided to the jukebox device (Figure 5, element 200), user input corresponding to a selection of an instance of media available for playback from the first and second pluralities of instances of media for playback on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5), and
gg. wherein each said instance of media in the first and second storage locations is of a common type (common types include music **206**, video **202**, and karaoke **204**).

42. Knowles does not expressly show:

hh. providing a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.
ii. wherein the first storage location is different from the second storage location.

43. However, Verduin shows a record player **42** which plays audio selections for a first price (Abstract and claim 1) as well as a VCR **54** which plays audio-video selections for a second price (Abstract and claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks **52** for different priced media because then the computer could identify the hard disk and charge accordingly instead of having to add metadata to the files or create a lookup table.

44. As to claim 62, Knowles further shows:

jj. the first and second storage locations respectively comprise first and second disk drive devices (Id.).

45. As to claim 65, Knowles further shows:

kk. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

46. As to claim 66, Knowles further shows:

ll. updating the first and second storage locations independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown

as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

47. As to claim 67, Knowles further shows:

mm. making available on the first storage location, at least temporarily, a selected instance of media from said second plurality of instances of media (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

48. Claims 71-80 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Shneidzman (US 2006/0038794).

49. As to claims 71, 74, 80 Knowles shows:

nn. A jukebox device **5** configured to playback an instance of media selected by a user ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5), comprising:
oo. at least one storage location **52** configured to store instances of media available for playback via the jukebox device (Figure 4A, step 120), the instances of media being divided into first and second subsets of media, the first and second subsets of media being different from one another (Figure 4A, steps 120 and 124) but each said instance of media in the first and second subsets of media being of a common type (common types include music **206**, video **202**, and karaoke **204**); and

pp. a user interface provided to the jukebox device configured to receive input from a user corresponding to a selection of an instance of media from the instances of media in order to initiate playback of the selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc.,

Figure 5),

qq. the user interface comprising a first display configured to receive input from a user for the selection of the instance of media for playback from the first subset of media **18** for a first fee or number of credits (as evidenced by Figure 4A, step 136), and

rr. the display configured to receive input from a user for the selection of the instance of media for playback from at least the second subset of media (Figure 4A, step 120) for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being greater than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower), and

ss. second display screen configured to enable a user to select the instance of media for playback (Figure 5, element 220).

50. Knowles does not expressly show that the list of media is searchable.

51. Shneidzman shows “multi-searchable jukebox type applications” (Paragraph [0063]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a search, as taught by Shneidzman, in order to allow users to access the system and provide them with different methods of finding and accessing the media.

52. As to claim 72, Knowles further shows:

tt. the first display screen includes a list of artists for each said instance of media in the first subset of media (“Touch here to sort by title or artist” Figure 5).

53. Knowles in view of Shneidzman teaches a list of artists being displayed on a jukebox.

However, it does not expressly teach the specific data recited in claim 73 (the album art).

Nevertheless, the difference(s) are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements.

The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.*

54. As to claim 75-77, Knowles further shows

uu. the second display is configured to display search results **220** after at least some instances of media not included in the first subset of media are searched by programmed logic circuitry for instances of media matching the search criteria **136**.

55. As to claim 78, Knowles further shows:

vv. the search results are selectable by the user in order to initiate playback of the selected search result by the jukebox device for the second fee or number of credits (as evidenced by Figure 4A, step 136).

56. As to claim 79, Knowles further shows:

ww. the first and second displays are each configured to allow a user to supply an additional fee or number of credits in order to make the selected instance of media play immediately after a currently playing instance of media (through element 20).

57. Claims 50, 51, 68, and 69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles and Verduin further in view of Bowman-Amuah (US 6,289,382).

58. The Knowles/Veerduin combination shows as described above in regards to claims 43 and 61 but does not show the encryption of the media as claimed in these claims.

59. However, Bowman-Amuah shows the encryption of the media in a jukebox system (Column 90, lines 25-37) by use of different mechanisms (Columns 81-82, lines 55-19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to encrypt the media as shown by Bowman-Amuah in order to prevent unwanted access to the media.

60. Claims 52 and 70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles and Bowman-Amuah as applied to claims 51 and 69 above, and further in view of Dunning (US 7,024,485).

61. The Knowles/Verduin/Bowman-Amuah combination discloses as discussed above, but does not expressly disclose:

xx. each instance of media in the second plurality of instances of media is missing a predetermined number of bytes, said missing bytes being stored in separate respective locations and being at least temporarily insertable into the respective instances of media to enable playback by the jukebox device.

62. However, Dunning shows a jukebox (Figure 2, 103) that splits the content file (Figure 3A, 2714) and only keeps a portion of it (Figure 3A, 2718). When the complete file is requested, the jukebox receives the other portion of the file (Figure 3C, 2734) and combines it with the part stored on the jukebox (Figure 3C, 2738). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Knowles to include the divided storage of Dunning for reasons including, preventing a complete copy of the file from residing on the jukebox where it could be copied (Dunning, Column 6, lines 24-25).

63. Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles and Shneidzman as applied to claim 71 above, and further in view of Verduin

64. The Knowles/Shneidzman combination teaches as discussed above in regards to claim 71 but does not expressly show:

yy. first and second storage locations respectively storing the first and second subsets of media.

65. However, Verduin shows a record player **42** which plays audio selections for a first price (Abstract and claim 1) as well as a VCR **54** which plays audio-video selections for a second price (Abstract and claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks **52** for different subsets of media represented by different priced media because then the computer could identify the hard disk and charge accordingly instead of having to add metadata to the files or create a lookup table.

Claim Interpretation

66. The Examiner hereby adopts the following interpretations under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these interpretations are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

zz. ***Configuration:*** “(1) (A) The arrangement of a computer system or component as defined by the number, nature, and interconnection of its constitute parts. ... (C) The physical and logical elements of an information processing system, the manner in which

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

they are organized and connected, or both. *Note:* May refer to a hardware configuration or software configuration.” The Authoritative Dictionary of IEEE Standards Terms, 7th Ed., IEEE, Inc., New York, NY, 12/2000.

aaa. **To:** “2a -- used as a function word to indicate purpose, intention, tendency, result, or end.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

67. Applicant's arguments with respect to claims 43, 44, 47-54, 57-62, and 65-81 have been considered but are moot in view of the new ground(s) of rejection.

68. Applicants argue:

69. “Because it is conceded that most of the allegedly objectionable terms have written description support, Applicant also wonders whether this objection could be overcome by simply amending the specification to insert such terms in exemplary locations. Of course, such a requirement would seem to elevate form over substance, effectively requiring action well beyond the strictures of 37 C.F.R. § 1.75(d)(1) and MPEP 608.01(o)” (Remarks, Page 13, Paragraph 1).

70. Examiner's response:

71. The Examiner disagrees with Applicants interpretation of the strictures of MPEP § 608.01(o). MPEP § 608.01(o) states “While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear

support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification.”

From this passage it is clear that the nomenclature must be consistent between the specification and the claims. This passage suggests amending the specification as mentioned by Applicants.

Generally, simply renaming an element does not result in the introduction of new matter.

However, as with any amendment, Applicants should ensure that the amendments to the specification do not introduce new matter.

72. Applicants arguments to the prior art rejections are understood to focus on the “type” of the instances of media. As set forth above, these limitations are new matter and indefinite. Because these limitations are new matter and indefinite, arguments to these limitations are not persuasive in overcoming the prior art.

Conclusion

73. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

74. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

75. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

bbb. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1st paragraph.

ccc. Independent of the requirements under 35 U.S.C. § 112 1st paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2)

amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

76. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m.

77. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

78. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua Murdough/
Examiner, Art Unit 3621

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